

REMARKS

Applicant respectfully requests reconsideration. Claims 1-19 were previously pending in this application. By this amendment, Applicant is canceling claims 1-13 without prejudice or disclaimer. Claim 14 has been amended. New claims 20-28 have been added. As a result, claims 14-15 and 18-28 are pending for examination with claim 14 being an independent claim.

New claims 20-28 find basis in previously pending claims 6, 8, 9, 10 and 12. Additional basis can be found in the specification as filed on page 3, line 13 to page 5, line 6, and on page 5, line 34 to page 6, line 2. Basis for new claim 27 can be found in the specification as filed on page 7, lines 3 to 11.

No new matter has been added.

Declaration

The Examiner objected to the declaration as defective for failing to comply with the requirements of 37 C.F.R. § 1.63(c).

Applicant respectfully traverses the requirement for a new declaration. Applicant properly complied with the requirements of 37 C.F.R. § 1.63(c), which state that “Unless such information is supplied on an application data sheet in accordance with § 1.76, the oath or declaration must also identify” the mailing address and zip code of each inventor and acknowledge the filing of foreign application(s).

Applicant previously filed an Application Data Sheet that provided all required information including mailing address of the inventors and an identification of priority applications. In addition, Applicant notes that the Declaration filed in the international phase of this application correctly identified the mailing address of the inventors including ZIP code.

In addition, Applicant submits herewith a Supplemental Application Data Sheet that provides the US serial number and filing date.

Accordingly, Applicant respectfully requests withdrawal of the objection to the declaration.

Rejections Under 35 U.S.C. §112

The Examiner rejected claims 1-11 and 13 under 35 U.S.C. §112, second paragraph, as indefinite.

Applicant has canceled claims 1-13, rendering the rejection moot.

Accordingly, withdrawal of the rejection of claims 1-11 and 13 under 35 U.S.C. §112 is respectfully requested.

Rejections Under 35 U.S.C. §103

1. The Examiner rejected claims 1-13 under 35 U.S.C. §103(a) as being unpatentable over Travis (U.S. Patent 6,541,510) in view of Turner et al. (J Clin Pharmacol. 1981; 21:283S-291S.) Applicant respectfully requests reconsideration.

Applicant has canceled claims 1-13, rendering the rejection moot.

Accordingly, withdrawal of the rejection of claims 1-13 under 35 U.S.C. §103 is respectfully requested.

2. The Examiner rejected claims 14-19 under 35 U.S.C. §103(a) as being unpatentable over Travis (U.S. Patent 6,541,510) in view of Turner et al. (J Clin Pharmacol. 1981; 21:283S-291S) as applied to claims 1-3, 5, 7-13 and further in view of Brooke et al. (U.S. Patent 6,328,992.) Applicant respectfully requests reconsideration.

The Examiner considers previously pending claims 1-13 to be obvious in light of the combination of Travis and Turner. However, as acknowledged by the Examiner on page 4 of the Office Action (last paragraph) neither document teaches or suggests the use of cannabichromene for the treatment of depression. Indeed, neither document teaches or suggests the use of cannabichromene for the treatment of a mood disorder. Thus the current claims are both novel and inventive over these documents.

The Examiner combines the Brooke et al. reference with the Travis and Turner references, alleging that Brooke teaches a medicinal use of cannabichromene in the treatment of depression. However, the disclosure of Brooke et al. does not specifically teach that cannabichromene is useful in the treatment of mood disorders such as depression, but rather suggests that cannabinoids have been used in this way. Therefore, there is no teaching in Brooke et al. that would specifically direct the skilled person towards the use of at least one compound of the general formula 1 such as cannabichromene in the treatment of mood disorders. The teaching found in Travis and Turner does not correct this deficiency and thus the combination of references cannot be considered to render the current claims obvious.

Even if the combination is viewed to provide the elements of the claimed invention, the person of ordinary skill in the art would not have a reasonable expectation of success in practicing the claimed methods based on the combined teachings of the Travis, Turner and Brooke references. Although “[o]bviousness does not require absolute predictability...at least some degree of predictability is required.” MPEP 2143.02.

None of the references in the combination provide such predictability. As noted previously the Travis and Turner references provide no information on treatment of mood disorders. Brooke teaches only generally that cannabinoids may be useful in treating a variety of disorders, but does not specifically teach that at least one compound of the general formula 1, such as cannabichromene, could be used for treatment of mood disorders. Brooke makes no reference to literature or patent references in support of the passage that the Examiner has cited, and indeed, there is no additional teaching in Brooke as to treatments of specific diseases with specific cannabinoids. Thus the skilled person is left with no guidance regarding the presently claimed method, and thus there is no predictability in practicing the claimed invention provided in the combination of references cited by the Examiner.

In considering what provides a reasonable expectation of success, the Federal Circuit has stated that “to have a reasonable expectation of success, one must be motivated to do more than merely to vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful.”

Medichem, S.A. v. Rolabo, S.L., 437 F.3d 1157, 1165 (Fed. Cir. 2006) (internal quotations omitted). The cited prior art does not provide motivation “to do more than merely to vary all parameters or try each of numerous possible choices”. The cited prior art gives “no indication of which parameters were critical” and give “no direction as to which of many possible choices is likely to be successful”. Therefore the cited combination of references provides no reasonable expectation of success as is required for a finding of obviousness.

Accordingly, withdrawal of the rejection of claims 1-13 under 35 U.S.C. § 103 is respectfully requested.

CONCLUSION

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the case in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,
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